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REMARKS/DISCUSSION OF ISSUES

Claims 1-16 and 18-19 are currently pending in the present application. Claims 1 and 9 are the independent claims.

Rejections Under 35 U.S.C. § 103(a)

1. Claims 1, 3, 9, 12-14 and 16-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Lane, et al. (U.S. Patent 5,148,230).

2. Claims 2, 4, 10, 11 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Lane, et al. further in view of Tanimoto, et al. (U.S. Patent 6,069,697).

3. Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Lane, et al. further in view of Swanson, et al. (U.S. Patent 6,580,531)

4. Claims 6-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Tanimoto, et al. further in view of Swanson, et al.

For at least the reasons that follow, it is respectfully submitted that the noted rejections are improper and that all rejected claims are patentable over the applied art.

An initial requirement of a proper rejection under 35 U.S.C. § 103(a) is that all of the claimed elements be found in the applied art. If a single claimed element is not found in the applied art, a prima facie case of obviousness cannot be properly established.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

I. Claim 1 is drawn to an optical testing unit for measuring sensitivity of an optical device under test (DUT). The optical testing unit features, inter alia, *"...a graphical user interface, which provides an interface with a user..."*

Claim 9, drawn to a method of optical testing includes a similar feature.

Illustratively Fig. 8 shows the GUI 160, which is described in detail in paragraphs [00064] through [00067] of the filed application. Notably, the GUI 160 provides a **point of interaction or communication** between a human operator and the optical testing unit. This interaction provides a **mutual or reciprocal** action or influence between the operator and the GUI 160. For example, the operator may initiate a calibration procedure by selecting discrete selection option 140; and the GUI may provide to the operator the results of the calibration.

The Office Action notes that the reference to Lane, et al. does not disclose a GUI. The Office Action attempts to

remedy this deficiency via the disclosure of a display device 32, which is a cathode ray tube device. To this end, the Office Action asserts that "...it would have been obvious that Lane would have to have a GUI as claimed in order to communicate between the memory and the display device." Clearly, and while in no way conceding that the quoted assertion is correct, Applicants respectfully submit that this is not the requirement for the establishment of *prima facie* case of obviousness. To wit, as noted above, the modifying of the teachings of the prior art to produce the claimed invention to establish of a *prima facie* case of obviousness requires a **teaching, suggestion or motivation to do so found in the reference itself**. Because the onus to establish a *prima facie* case of obviousness lies on the Office, and because the Examiner has failed to disclose the requisite teaching suggestion or motivation from the reference to modify the reference applied, it is respectfully submitted that a proper *prima facie* case of obviousness has not been established.

The above traversal of the rejection of claim 1 notwithstanding, it is noted that the reference to *Lane, et al.* discloses an interface 40', separate from the display, to generate beginning and end signals representing respective addresses in memory 50. Clearly, this is not a graphic user interface as specifically recited in claim 1. Accordingly, it is respectfully submitted that the reference to *Lane, et al.* lacks at least the disclosure of at least one feature of claim 1.

The Office Action also notes the lacking of the disclosure of a sensitivity module. The Office attempts to cure this deficiency through the modification of the memory 52. However, there is no disclosure of the requisite

teaching, suggestion or motivation to do so found in the reference itself provided in the Office Action.

For at least the reasons set forth above, it is respectfully submitted that claims 1 and 9, and the claims that depend directly or indirectly from claim 1 are improperly rejected and are patentable over the applied art. Allowance is earnestly solicited.

II. The rejection of claims 2, 4, 5-8, 10, 11 and 15 is also improper. Notably, these claims depend directly or indirectly from either independent claim 1 or independent claim 9. For reasons set forth above it is respectfully submitted that these independent claims are patentable, thus all claims that depend from these claims are also patentable. Thus, while Applicant neither concedes the propriety of the rejections or the combination of the references, it is respectfully submitted that claims 2, 4, 5-8, 10, 11 and 15 are patentable.

Conclusion

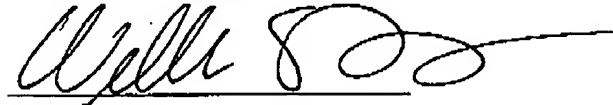
In view of the foregoing, applicants respectfully request the withdrawal of the objections and rejections of record, the allowance of all pending claims, and the holding of the application in condition for allowance.

If any points remain in issue, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

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period of response to March 2, 2005.

Respectfully submitted on behalf of
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